

REMARKS

Applicant has carefully reviewed the Application in light of the Final Office Action mailed November 4, 2004. At the time of the Office Action, Claims 36-46 were pending in the Application. Applicant amends Independent Claim 36. The amendment to the claim is not the result of any prior art reference and, thus, does not narrow the scope of any of the claims. Furthermore, the amendment is not related to patentability issues and only further clarify subject matter already present. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 and 103 Rejections

The Examiner rejects Claims 36-46 under 35 U.S.C. §102(e) as being anticipated by copending application No. 09/608,657. The Examiner rejects Claims 36-44 and 46 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,647,035 issued to Cadeddu et al. (hereinafter "*Cadeddu*"). The Examiner rejects Claim 45 under 35 U.S.C. §103(a) as being unpatentable over *Cadeddu* in view of Ramaswami et al. (i.e. an article entitled "Optical Networks: A Practical Perspective," hereinafter "*Ramaswami*"). These rejections are respectfully traversed for the following reasons.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (See M.P.E.P. §2131.) Additionally, in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. (See M.P.E.P. § 2142-43.)

Cadeddu cannot properly support a §102 rejection because it fails to teach, suggest, or disclose each and every limitation of Independent Claim 36. In a similar fashion in addressing the §103 rejection, it is respectfully submitted that the pending claims are patentable over the art of record based on, at least, the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation.

For example, as amended, Independent Claim 36 generally recites a response to a failure condition that is executed on a channel level, whereby a set of transmission wavelengths include more than one transmission wavelength such that one of the transmission wavelengths can be

switched while other transmission wavelengths in the set are not, a selected one of the set of transmission wavelengths may be reserved on the first optical carrier during normal operative conditions and during a failure, the selected wavelength is implemented on the first optical carrier. First, neither *Cadeddu* nor *Shiragaki* perform such channel level operations, particularly those in the context of the aforementioned transmission wavelengths and the identified optical carrier configuration. Second, the structure of *Cadeddu* and *Shiragaki* are not capable of maintaining such a wavelength relationship, as identified by Independent Claim 36.

Applicant further notes that any combination of *Shiragaki* and *Cadeddu* and some other reference that may disclose such operations would be inappropriate in the context of a future potential §103 rejection. This is because there is no evidence to suggest that *Shiragaki* and *Cadeddu* would be capable of successfully performing the requisite operations. In addition, there is no evidence to support that either of these references could maintain the relationship between the set of transmission wavelengths such that one of the transmission wavelengths can be switched while other transmission wavelengths in the set are not. Nor is there any disclosure to support an arrangement that allows for a selected one of the set of transmission wavelengths to be reserved on the first optical carrier during normal operative conditions and during a failure, the selected wavelength is implemented on the first optical carrier. Moreover, there is no teaching, disclosure, or suggestion to make any such future combinations. These essential facts would vitiate the other prongs obviousness and, therefore, render the pending claims allowable.

Thus, Independent Claim 36 is allowable over *Cadeddu* and *Shiragaki*. In addition, the dependent claims associated with Independent 36 Claim are also allowable for analogous reasons.

Double Patenting and Provisional Rejections

The Examiner provisionally previously rejected Claims 36-39, 41-44, and 46 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 2 of copending Application No. 09/608,657 in view of *Cadeddu*. The Examiner also provisionally previously rejected Claim 45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 2 of copending Application No. 09/608,657 in view of *Cadeddu* as applied to Claim 36, and further in view of *Ramaswami*.

Applicant stands prepared to submit a Terminal Disclaimer in order to overcome the nonstatutory double patenting rejection. Any filing of the Terminal Disclaimer should not be construed as an agreement with or an acquiescence to the propriety thereof. Applicant reserves the right to comment on the appropriateness of the Terminal Disclaimer at a future time, should Applicant deem it appropriate to do so.

CONCLUSION

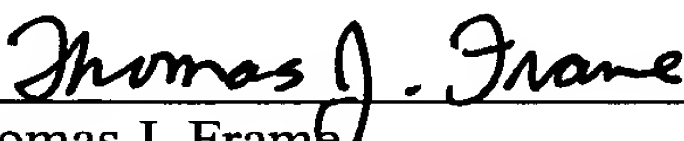
Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fees are due. If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas J. Frame, at (214) 953-6675.

Respectfully submitted,

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